

REMARKS

Applicants thank the Examiner for the consideration given the present application. Upon entry of the claim amendments herein, Claims 17-28 will be pending in the present application. Applicants have amended Claim 17 and canceled Claims 1-16. Claim 28 has been added. Applicants respectfully assert that no new matter is presented.

Specifically, Claim 17 has been amended to change the phrase "one or more vitamins" to "two or more vitamins." Support for this amendment is found in Claim 1 as originally filed.

Claim 28 has been added and reads "A beverage composition according to Claim 27 comprising vitamin A and vitamin E." Support for this new claim is found in Claim 13 as originally filed.

The Rejection under 35 U.S.C. § 102

The Examiner has rejected Claims 1-3 under 35 U.S.C. § 102 (a) as being anticipated by Glaceau Vitaminwater (herein "Glaceau"). Additionally, the Examiner has rejected Claims 1-4, 7 and 8 under 35 U.S.C. § 102 (b) as being anticipated by Fuse et al., JP-2-154,673 (herein "Fuse"). Furthermore, the Examiner has rejected Claims 1, 2, 17 and 18 under 35 U.S.C. § 102 (b) as being anticipated by McAnalley, WO 98/06418 (herein "McAnalley"). Each rejection is addressed below.

Synopsis of the Invention

The present invention is directed to beverage compositions containing supplemental vitamins. Vitamin supplementation is common in the field of beverage compositions. However, vitamin solubility can be a serious problem when formulating beverage compositions with fat-soluble vitamins, such as vitamins A, D and E, which cause such formulation to be either unfeasible or unacceptable due to insolubility and, ultimately, instability of the desired vitamin supplement. In such beverage compositions, the vitamin may ultimately settle to the bottom of a container which holds the composition.

It is therefore important to develop methods in which fat-soluble vitamins may be solubilized or stabilized in the beverage composition. Various methods have been attempted and are commonly used, for example, emulsification. However, emulsifiers typically utilized do not provide any nutritive benefit in addition to support of the vitamin in the beverage composition.

The present inventors have quite surprisingly discovered that foregoing problems are overcome in beverage compositions comprising a fiber known as arabinogalactan and fat-soluble vitamins, including vitamin A, vitamin D and vitamin E. The arabinogalactan fiber is useful for providing a dietary fiber benefit to the consumer, as well as additional benefits in the field of

immune function. It is therefore quite exciting that this fiber may be used, not only to provide these benefits, but also to stabilize the defined vitamins as well. In addition, use of a fiber to attempt this purpose would ordinarily result in increased viscosity and likely unacceptability of the final beverage product. However, it has further been found that the arabinogalactan fiber is not precluded from use due to any problems associated with viscosity. In fact, the beverage compositions of the present invention provide excellent viscosity, which is acceptable to the consumer.

Examiner's Rejection

The Examiner has used Glaceau, Fuse and McAnalley to collectively reject Claim 1-4, 7 and 8. As Claims 1-4, 7 and 8 are among the claims canceled herein, Applicants respectfully request these rejections be withdrawn.

In regards to the remaining claims pending in the present application, the Examiner has rejected Claim 17 and 18 as being anticipated by McAnalley under 35 U.S.C. § 102(b). In particular, the Examiner argues that McAnalley discloses a composition as in Claim 17, which can be in liquid form, and is therefore considered a beverage, which contains arabinogalactan and vitamins A, B, C, D, and E and is within the ranges claimed in Claim 18.

Applicants' Argument

Under 35 U.S.C. § 102, a claim is anticipated only if each and every claim element is found, either expressly or inherently disclosed, in a single prior art reference. See *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there. See *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 43 USPQ2d 1481, 1490 (Fed. Cir. 1997). Additionally, there must be no difference between what is claimed and what is disclosed in the applied reference. See *Scripps v. Genetech Inc.*, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). Moreover, it is incumbent on the Examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference. *Ex parte Levy*, 17 USPQ2d 1461, 1462 (BPAI 1990).

As aforementioned, the Examiner has rejected Claims 17 and 18 under 35 U.S.C. as being anticipated by McAnalley. While Applicants respectfully disagree with the Examiner's conclusion of anticipation, in a sincere effort to advance prosecution. Applicants have herein amended Claim 17 to require "two or more vitamins selected from the group consisting of vitamin A, vitamin D and vitamin E." Applicants respectfully assert that McAnalley fails to teach the

particular combination of arabinogalactan with two or more fat-soluble vitamins, and therefore, fails to teach *each and every* claim element of the present invention. Rather, McAnalley broadly discloses dietary supplements containing saccharides and, in one variation, vitamins and minerals. As amended herein, the present invention specifically requires the combination of arabinogalactan and two or more fat-soluble vitamins, in order to achieve the previously discussed surprising benefits. Because McAnalley fails to teach this specific combination, as required to do under 35 U.S.C. § 102, Applicants respectfully assert that McAnalley fails to anticipate the present invention as amended herein.

Moreover, Applicants respectfully assert that McAnalley fails to meet the requirement that there be no difference between what is claimed and what is disclosed in the applied reference. As aforementioned, the present inventors have surprisingly discovered that the combination of arabinogalactan and two or more fat-soluble vitamins provides increased solubility and stability of the beverage compositions. In contrast, the dietary supplements of McAnalley require the inclusion of water-soluble vitamins and minerals. See *McAnalley*, Claim 17. Applicants respectfully assert that this requirement of water-soluble vitamins and minerals presents a substantial difference from the present invention. Because McAnalley teaches a substantially different formulation than disclosed herein, Applicants respectfully assert that McAnalley fails to anticipate the present invention, as amended herein.

Thus, because McAnalley fails to teach each and every element of the invention disclosed herein, and because McAnalley requires a substantially different formulation than presently taught, Applicants respectfully assert that McAnalley fails to anticipate the present invention under 35 U.S.C. § 102, and respectfully request the rejection be withdrawn.

The Rejection under 35 U.S.C. § 103

The Examiner has rejected Claims 1-27 under 35 U.S.C. § 103 as being unpatentable over Celestial Seasonings Echinacea Complete Care (herein "CS"), or Glaceau, or Odwalla Introduces Glorious Morning (herein "Odwalla"), in view of McAnalley, or taken alone, and also in view of Fuse. For the following reasons, Applicants respectfully traverse this rejection.

The Rejection and Cited Art

The Examiner has rejected Claim 1-27 over CS, Glaceau or Odwalla, either alone or in combination with McAnalley, and further in view of Fuse. Specifically, the Examiner cites CS as disclosing a composition containing arabinogalactan and vitamin C. While the Examiner admits that CS teaches capsules rather than beverage compositions, the Examiner argues that "a beverage

is no more than a drinkable liquid.” and states that there is no water even seen in the Applicants’ invention. The Examiner continues by restating the rejection made under §102 above, and concludes that it would have been obvious to make the beverage compositions claimed herein by using the ingredients of McAnalley in liquid form.

Next, the Examiner again cites McAnalley as disclosing a dry beverage composition containing arabinogalactan from the Larch tree, and states that, although McAnalley fails to teach the particular amount of arabinogalactan disclosed herein, it would have been obvious to one of ordinary skill to vary the arabinogalactan content based on desired viscosity. Thus, the Examiner concludes it would have been obvious to use the disclosed ingredients to make a dry beverage composition.

The Examiner concludes by stating that there is nothing new about the vitamins, or amounts thereof, disclosed in the claims of the present invention and that it would have been obvious to one of ordinary skill in the art to use such vitamins and such levels as disclosed herein.

Finally, Applicants respectfully assert that the Odwalla reference is not prior art under 35 U.S.C. § 102 and, therefore, is not a proper basis of rejection under 35 U.S.C. § 103. Specifically, the Odwalla reference has a publication date of September 6, 2001. The present application was filed on August 4, 2001, and makes a proper claim of priority to a provisional application filed on September 29, 2000. Therefore, because the present application has an effective filing date prior to the publication of the Odwalla reference, Applicants respectfully assert the Odwalla reference is an improper basis for rejection under 35 U.S.C. § 103, and because of this, the reference will not be discussed further.

The Argument

The Examiner bears the burden of factually supporting any prima facie conclusion of obviousness. In determining the differences between the cited art and the claims, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. See Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fe. Cir. 1983). Distilling the invention down to the “gist” or “thrust” of an invention disregards the requirement of analyzing the subject matter “as a whole.” See W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983). If, viewing the invention as a whole, the Examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of non-obviousness. See In re Fritch, 972 F.2d 1260 (Fed. Cir. 1992). Inventors of unobvious compositions, such as those of the present invention, enjoy a *presumption* of non-obviousness, which must then be overcome by the Examiner establishing a case of prima facie

obviousness by the appropriate standard. If the Examiner does not prove a prima facie case of unpatentability, then without more, the Applicants are entitled to grant of the patent. *See In re Oetiker*, 977 F.2d 1443.

As aforementioned, the Examiner has not satisfied the burden of establishing a prima facie case of obviousness. To establish a prima facie case of obviousness under 35 U.S.C. §103, the Examiner must meet three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest *all* the claim limitations. *See*, for example, *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Applicants respectfully assert that the Examiner fails to establish the first and third criteria, and thus, fails to establish a prima facie case of obviousness.

First, Applicants respectfully assert that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the individual references or combine reference teachings. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Applicants respectfully assert that the Examiner's presumptions that "a beverage is no more than a drinkable liquid," and thus "it would have been obvious to make a composition containing the claimed arabinogalactan and vitamins in the claimed amounts," does not satisfy the requirements for establishing the first criteria of a prima facie case of obviousness.

Applicants respectfully assert that the cited references, either alone or in combination, do not teach or suggest the beverage compositions of the present invention, which may be either a dry concentrate or a ready-to-drink beverage. *See Claims 21 and 23* respectively. Neither CS, nor Glaceau, either alone or in view of McAnalley, or Fuse, teaches or suggests the beverage compositions of the present invention. Moreover, there would be no motivation to combine CS with the other reference since CS teaches a capsule, while the other references generally disclose liquid compositions. Furthermore, of those references disclosing liquid compositions, there is no teaching or suggestion of a beverage compositions requiring arabinogalactan and two or more fat-soluble vitamins. Indeed, Applicants respectfully assert that the Examiner has in fact used the Applicants' own disclosure to find the requisite motivation needed to declare such beverage compositions obvious. As this is an improper source for obviousness determination purposes, Applicants respectfully assert that the first requirement for establishing a prima facie case of obviousness has not been satisfied.

Furthermore, Applicants respectfully assert that none of the cited references, either alone or in combination, teach or suggest *all* the claim limitations. The present invention is directed specifically to beverage compositions comprising arabinogalactan and two or more fat-soluble vitamins, namely vitamins A, D and E. None of the cited art, either individually or in combination, teaches this specific formulation.

CS may generally disclose arabinogalactan and vitamin C, but it is a capsule, not a beverage. Moreover, CS teaches only water-soluble vitamins rather than fat-soluble vitamins. Applicants respectfully assert that there is nothing in the remaining cited references that corrects these deficiencies in CS. Additionally, while Glaceau, Fuse and McAnalley may generally disclose liquid or beverage compositions containing arabinogalactan, none specifically limit the included vitamins to fat-soluble vitamins. As discussed previously, fat-soluble vitamins present unique solubility and stability issues in beverages, and thus, the inclusion of water-soluble vitamins cannot be said to make the inclusion of fat-soluble vitamins obvious. Therefore, because the cited references fail to teach all the limitations of the present claims, Applicants respectfully assert that the third criteria for establishing a prima facie case of obviousness has not been satisfied.

Thus, because the cited references, either alone or in combination, fail to provide the motivation to modify or combine the references, and fail to provide a teaching of all limitations of the present claims, Applicants respectfully assert that a prima facie case of obviousness had not been established. Therefore, it is respectfully requested that the obviousness rejection under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the Examiner's rejections under 35 U.S.C. §§ 102 and 103 are improper. Reversal of such rejections is therefore respectfully requested.

Respectfully submitted,

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